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10/531,246

04/14/2005

Robert Harris

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SUITE 3020

BOCA RATON, FL 33487

EXAMINER

ARAQUE JR, GERARDO

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,246	Applicant(s) HARRIS, ROBERT
	Examiner Gerardo Araque Jr.	Art Unit 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 13 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 13 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

2. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

3. The information disclosure statement filed **4/14/2005** fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

5. The information disclosure statement filed **4/14/2005** fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the applicant has not provided a full copy of documents needed to be submitted with the 371 application, copies of the non-patent literature and references listed in the IDS, and has not provided a copies of references listed in the specification, such as ¶ 6 regarding the UDDI website. It has been placed in the application file, but the information referred to

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therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 13** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. **Claim 13** recites the limitation "**the hierarchy**" in **line 4 of claim 13**. There is insufficient antecedent basis for this limitation in the claim.

9. **Claim 13** recites the limitation "**the ranker machine**" in **line 14 of claim 13**.

There is insufficient antecedent basis for this limitation in the claim.

10. In regards to **claim 13**, the Examiner asserts that "a web service architecture" is improper since it does not specifically disclose an appropriate statutory category. For the purposes of expediting prosecution and based on the information provided in the specification the Examiner will assume that "a web service architecture" is directed to software since no structure has been provided in the claims or in the specification.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claim 1** is rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is sufficiently tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not sufficiently tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **claim 1** is non-statutory since they may are not tied to another statutory class.

13. **Claim 13** are rejected under 35 U.S.C. 101 because the applicant is claiming a system with no structural components. As best understood by the Examiner from the

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applicant's specification, the limitations set forth in the claims are directed to software and software, per se, is not statutory. Moreover, the Examiner notes that the applicant is claiming the system by what it does and not by the structure to perform the claimed invention.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1, 13, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mendelevitch (US PGPub 2003/0130993 A1)**.

16. In regards to **claims 1, 13, and 20**, **Mendelevitch** discloses a method for ranking services in a web services architecture having a hierarchy of services with a root originating service requestor, a service of a first level in the hierarchy calling a service of a lower level, the method comprising:

indicating a preference regarding at least one service and a ranking machine having a choice algorithm based on the preference (**Page 2 ¶ 14; Page 4 ¶ 47; wherein a user provides parameters into the system and a classification engine which provides confidence scores [rankings] is provided**);

finding a set of possible lower-level services by a service using a directory at each level of the hierarchy (**Page 2 ¶ 13; see also Claim 13; wherein a set of**

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documents are searched through a database [directory] which is arranged in a hierarchy structure); and

applying the choice algorithm to the set of possible lower-level services, wherein the lower-level services are selected from service requestors or service providers **(Page 3 ¶ 43 wherein computer code is executed and applied to the documents in the directory);**

referring the set of possible lower-level services to the ranking machine from the directory and returning a preferred sequence by the ranking machine to the directory, wherein the referring the set of possible lower-level services to the ranking machine from the directory is not visible to the service using the directory **(Page 1 ¶ 12; Page 4 ¶ 47, 49 – 53 wherein the classification engine receives the documents in order to process them by classifying and ranking the documents and wherein the processing is performed in the background, which obviously results in the processing being performed in a manner that is not visible to the user); and**

sending the set of possible lower-level services by the service using the directory to the ranking machine and returning a preferred sequence by the ranking machine to the service, wherein lower-level invocations of services in the hierarchy are not visible to higher-level services **(Page 1 ¶ 12; Page 4 ¶ 47, 49 – 53 wherein the classification engine receives the documents in order to process them by classifying and ranking the documents and wherein the processing is performed in the background, which obviously results in the processing being performed in a manner that is not visible to the user and wherein the final list of documents will**

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be provided to the user after the process has been performed by the classification engine).

Mendelevitch discloses a method and system which provides a user (a requestor) with a classification engine that is connected (which obviously includes the use of a port) to a database in order to process documents in a database [directory]. Specifically, **Mendelevitch** provides a classification engine which takes into account the user's parameters in order to properly classify and rank the documents.

However, **Mendelevitch** fails to explicitly disclose wherein the documents are directed to services, i.e. lower-level services. Specifically, **Mendelevitch** fails to disclose:

- invoking services;
- set of possible lower-level services;
- service requestors or service providers;
- a UDDI directory;
- TModels; and
- XML.

However, the Examiner asserts that the data stored in the directory is directed to non-functional descriptive subject matter. That is to say, the type of data, i.e. lower-level services, level of services, service requestors, and service providers, does not affect how the method is carried out or stores the information. The type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be

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performed in the same manner regardless of the type of data that is being processed or stored.

With that said, it would have also been obvious to one having ordinary skill in the art of web services, and as admitted by the applicant in the Background, to have used a tModel, since a tModel is a data structure representing a service type in a UDDI registry. With that in mind, it is further asserted that one of ordinary skill in the art would have also recognized the use of XML using the said structure since a web service is described using a standard, formal XML notation, called a service description.

Consequently, it is asserted that one of ordinary skill in the art would have found it obvious to use a UDDI directory as a means of find a service, and turning the set of data, i.e. tModel bags, into a set of tModels, wherein the underlying UDDI application code carries out the referral and appends the location of the ranker machine to subsequent XML flow, since all of the above processes are old and well known methods known in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention that the sole difference between the primary reference and the claimed invention is that the primary reference does not disclose that the documents are directed to services, but would have realized that ultimately both are types of data. With that said, one of ordinary skill in the art would have recognized that each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself- that is in the substitution

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of the documents, as taught by **Mendelevitch**, with the specific type of documents (data) describing services.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.'

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
2/3/09

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
February 11, 2009